

REMARKS / DISCUSSION OF ISSUES

Claims 1-9, 19 and 20 are pending in the application. Claims 10-18 and 21-34 were cancelled in a previous response to a requirement of restriction.

Obviousness-type Double-Patenting Rejection

The rejections under the non-statutory obviousness-type double-patenting have been considered. While Applicants do not concede their propriety, if these rejections remain the only obstacle to allowance, and it is necessary and proper to do so, Applicants will file a terminal disclaimer to negate the rejections.

Rejections under 35 U.S.C. § 102

Claims 1-9, 19 and 20 were rejected under 35 U.S.C. § 102(a) as allegedly being unpatentable over *Kraus, Jr., et al.* (U.S. Patent 6,470,220). For at least the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the applied art.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim.¹ Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.² Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice.³

¹ See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

² See, e.g., *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

³ See, e.g., *Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).

For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.⁴

a. Claim 1

Claim 1 recites:

A device for determining mechanical, particularly elastic, parameters of an examination object, comprising a) at least one arrangement for determining the spatial distribution of magnetic particles in at least one examination area of the examination object, comprising a means for generating a magnetic field with a spatial profile of the magnetic field strength such that there is produced in at least one examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength, a means for detecting signals which depend on the magnetization in the examination object, particularly in the examination area, that is influenced by a spatial change in the particles, and a means for evaluating the signals so as to obtain information about the, in particular temporally changing, spatial distribution of the magnetic particles in the examination area; and b) at least one means for generating mechanical displacements, in particular oscillations, at least in and/or adjacent to the examination area of the examination object.

Applicants respectfully submit that the applied art fails to disclose at least the emphasized feature of claim 1. In rejecting the emphasized portion of claim 1, the Office Action directs Applicants to “SQUID” at column 7, lines 60-67, and to col. 13, line 9 through column 14, line 25 of *Kraus, Jr., et al.* The portion of column 7 relied upon describes SQUID sensors, which are magnetometers useful in detecting extremely weak magnetic fields. The portions of column 13 and 14 relied upon describe application of time-varying spatial distribution of magnetic fields by movement of coils or by rotation of the field distribution by a set of computer controlled magnetic induction coils that are

⁴ See, e.g., *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

distributed and phased to produce the desired field distributions and rotational frequency. However, while phase lag of particle precession in viscous environments are described, there is no disclosure of producing *in at least one examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength*. Furthermore, while a system for conducting both treatment and temperature measurement are described including a combination of electromagnetic field-generating coils and squid devices, there remains a deficiency of producing *in at least one examination area a first part-area having a low magnetic field strength and a second part-area having a higher magnetic field strength* as is specifically recited in claim 1. (Kindly refer to column 13, lines 10-40 and line 63-column 14, line16 of *Kraus, Jr., et al.* for support for these assertions.)

Accordingly, and for at least the reasons set forth above, Applicants respectfully submit that *Kraus, Jr., et al.* fails to disclose at least one feature of claim 1. As such, a *prima facie* case of anticipation has not been established, and claim 1 is patentable over the *Kraus, Jr., et al.* Furthermore, claims 2-9, 19 and 20, which depend immediately or ultimately from claim 1, are patentable for at least the same reasons and in view of their additionally recited subject matter.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

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